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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,270	07/12/2000	William A. Cooper	11348.36US01	2127
40581	7590	09/28/2005		
CRAWFORD MAUNU PLLC 1270 NORTHLAND DRIVE, SUITE 390 ST. PAUL, MN 55120			EXAMINER COLBERT, ELLA	
			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/614,270

Applicant(s)

COOPER, WILLIAM A.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 45-66 are pending in this communication filed 07/01/5 entered as Response After Non-Final Action.
2. The 35 USC 101 Rejection still remains as set forth here below and addressed in the Response to Arguments section of this communication.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 45-66 are rejected under 35 U.S.C. 101 as non-statutory. The method and system claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method or system claim that includes in the body of the claim at least one structural/functional interrelationship which can only be computer implemented is considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claim 45 hints at technology in the body of the claim in the last limitation reciting "... automatically transferring funds for the transaction card purchases and a communication protocol implemented with the user". However, Applicant needs to establish in the body of the claim that a machine is performing the steps.

The "purchase transaction system" in the preamble would be better incorporated into the body of the claim. Suggestion for the preamble: A purchase transaction system for managing transaction cards issued to respective users relative to their status at a banking institution at which they hold a consideration-bearing bank account, the system comprising a computer arrangement configured and arranged for: .

Response to Arguments

4. Applicant's arguments filed 7/01/05 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Applicant respectfully traverses the Section 101 rejection because the apparent basis of the rejection, that the "Applicant needs to establish in the body of the claim that a machine is performing the steps," fails to consider the limitations in claim 45 directed to a system "comprising a computer arrangement configured and arranged ..." These limitation, directed to a computer arrangement configured and arranged to perform claimed functions, meet the requirements of Section 101 and in addition to the above, statements in the rejection are contradictory to the asserted rationale in the rejection, in that page 2 of the Office Action suggests that "a computer implemented" system has a technological basis, yet the rejected claim is directed to a computer arrangement. The rejection further goes on to suggest a claim amendment to include, in claim 45, a "computer arrangement configured and arranged for ..." where claim 45 already includes this language and Applicant submits that the rejection is unclear and appears to suggest that claim 45, which is directed to subject matter including a computer, is an appropriate claim under

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section 101 as acknowledged on pages 2 and 3 of the Office Action has been considered but is not deemed persuasive. Response: The Examiner disagrees with these assertions because the Applicant is misinterpreting the 35 USC 101 rejection. First, the recitation "comprising a computer arrangement configured and arranged ..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) and second, the body of the claim needs to have a machine to perform the method steps of the claim otherwise it is interpreted that the process can be performed manually since the body of the claim only hints at technology.

The Examiner in the prior Office Action, gave the Applicant suggests as to how the 35 USC 101 Rejection could be overcome. It is up to the Applicant how the Applicant wants to amend the claim to overcome the rejection.

It is respectfully requested Applicant amend claims 45 and 56 to overcome the outstanding rejection in an effort to move the application forward.

Inquiries

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert
Primary Patent Examiner
September 22, 2005